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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

GRAVINI, STEPHEN MICHAEL

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 07/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/714,574

Applicant(s)

John PACKES, Jr. et al.

Examiner

Stephen M. Gravini

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6-22-01
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2 6) ☐ Other:

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DETAILED ACTION

Requirements for Information

1. 37 CFR 1.105 states: (a) (1) In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under §1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, for example:

- (I) Commercial databases : The existence of any particularly relevant commercial database known to any of the inventors that could be searched for a particular aspect of the invention.
- (ii) Search : Whether a search of the prior art was made, and if so, what was searched.
- (iii) Related information : A copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention.
- (iv) Information used to draft application : A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application.

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(v) Information used in invention process : A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result.

(vi) Improvements : Where the claimed invention is an improvement, identification of what is being improved.

(vii) In Use : Identification of any use of the claimed invention known to any of the inventors at the time the application was filed notwithstanding the date of the use.

(2) Where an assignee has asserted its right to prosecute pursuant to § 3.71(a) of this chapter, matters such as paragraphs (a)(1)(I), (iii), and (vii) of this section may also be applied to such assignee.

(3) Any reply that states that the information required to be submitted is unknown and/or is not readily available to the party or parties from which it was requested will be accepted as a complete reply.

(b) The requirement for information of paragraph (a)(1) of this section may be included in an Office action, or sent separately.

(c) A reply, or a failure to reply, to a requirement for information under this section will be governed by §§ 1.135 and 1.136.

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2. The Office is requiring submission of information reasonably necessary to properly examine and treat the claimed subject matter under Rule 105. Of particular interest is information used in drafting the present operation including information related to applicant's assignee (Walker Digital), business practices used by applicant's professional business ventures, to show the information used in the invention process, and identification of any use of the claimed invention known to the inventor at the time the application was filed notwithstanding the date of the use.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-22 and 28 are rejected under 35 U.S.C. 101 because the claimed method does not recite a useful, concrete and tangible result under *In re Alappat*, 31 USPQ2d 1545 (Fed. Cir. 1994) and *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 47 USPQ2d 1596 (Fed Cir. 1998). The independently claimed invention is an abstract idea which can be performed without interaction of a physical structure. The independently claimed steps of receiving, detecting, identifying, determining, and/or offering does not require structural interaction or mechanical intervention such that the invention falls withing the technological arts

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permitting statutory patent protection. Those steps can be performed by interpersonal communications such that the claimed steps can be performed without a physical structure or mechanical object. Because the independently claimed invention is directed to an abstract idea and does not require structural interaction or mechanical intervention, it does not produce a useful, concrete and tangible result, is not permitted under 35 USC 101 as being related to non-statutory subject matter. Furthermore each of the claimed steps can be completely performed by a human which further illustrate that the independently claimed invention is directed to an abstract idea and does not require structural interaction or mechanical intervention. However in order to examine the claimed invention in light of the prior art, further rejections will be made on the assumption that those claims are statutorily permitted.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-28 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the

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invention. In this case, the independently claimed method and system including the steps of identifying a condition at a retail establishment and based on the condition, outputting an offer to the customer in response to the received request including a condition of a transaction request, detecting a condition, and generating a trigger signal are not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The independently claimed steps of specifically reciting those steps are considered non-enabling because the specification does not provide a concrete example or illustrating of those claimed steps. The specification discusses these claimed concepts but does not enable one skilled in the art how the steps of identifying a condition at a retail establishment and based on the condition, outputting an offer to the customer in response to the received request including a condition of a transaction request, detecting a condition, and generating a trigger signal are enabled, based on the specification, such that one would know how to make and/or use the invention. However in order to examine the claimed invention in light of the prior art, further rejections will be made on the assumption that those claims are reasonably conveyed to those skilled in the art.

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7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The independently claimed method and system including the steps of identifying a condition at a retail establishment and based on the condition, outputting an offer to the customer in response to the received request including a condition of a transaction request, detecting a condition, and generating a trigger signal fails to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The independently claimed steps of specifically reciting those features are considered indefinite because the claims do not provide an antecedent basis of those steps. The specification and claims discuss these claimed concepts but does not particularly point out and distinctly claim the subject matter which applicant regards as the invention because it is considered that, as discussed in the specification, is considered indefinite. Some of the claims are also rejected for introducing terms without a proper antecedent basis from within the claim or its depending claim. These terms include "the step" (claims 10 and 11) and "the requested transaction" - multiple occurrences (claim 13). However in order to examine the claimed invention in light of the prior art, further rejections will be made on the assumption that those claims are not indefinite.

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9. The following is a quotation of the sixth paragraph of 35 U.S.C. 112:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

10. Claims 23-27 are rejected under 35 U.S.C. 112, sixth paragraph, as not setting a limit on how broadly the Office may construe means-plus-function language under the rubric of reasonable interpretation (please see MPEP 2181). The independently claimed vending machine sales promotions with separate steps including various means is not construed means-plus-function language under the rubric of reasonable interpretation, because the specification does not provide a clear limit of patentability. The separate steps including various means are merely exemplified after the “for” recitation and may incorporate any function that could be taught in the prior art. In order to consider that claim in light of the prior art, examiner will assume that those claims contain a clear limitation under the broadest reasonable interpretation.

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Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(c) he has abandoned the invention.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1-28 are rejected under 35 U.S.C. 102(a) as being anticipated by applicant's specification to each of the independently claimed inventions. Since the specification background is customarily used as an introduction to admitted prior art while the claims introduce improvements to the admitted prior art, the independently claimed invention mirrors the specification in subject matter and functionality. In this case the claims contain the same subject matter as the specification background and since the background is normally admitted prior art, the claims and claims depending upon them are considered anticipated by the specification admitted prior art. Claims 1-28 are further rejected under 35 U.S.C. 102(b) as being clearly anticipated by Sedam et al. (US 4,412,292), Groover et al. (US 4,717,043), Gupta et al.

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(WO 93/04449), Powell (WO 96/39671), Cragun et al. (US 5,504,675), Helbing et al. (US 5,546,303), Fite et al. (US 5,557,721), Molbak (US 5,620,079), Burke (US 5,621,640), Naftzger (US 5,717,866 or US 5,924,078), MacLean IV (US 5,771,778), Peters (US 5,769,269), or Miller et al. (US 5,959,869), and are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Kolls (US 6,056,194), Kreymin et al. (US 6,067,570), Pucci et al. (WO 00/30010) or Terranova (US 6,098,879).

13. Claims 1-28 rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention. An internet search and a trademark database search has revealed that the claimed invention has been in public use or on sale for more than one year from the filing of the present invention. The applicants' assignee has at least two US patents (US 5,794,207 and US 6,196,458) issued with filing dates and/or publication dates as early as 1997 which is before the filing date of the present application in late 2000. Furthermore an Office cited New York Times article in 1997 quotes a principal of the assignee admitting the claimed invention in 1999 which is more than one year from the filing of the present invention. Since the claimed invention has been in public use or on sale for more than one year from the filing of the present application, it is statutorily barred from patenting within the United States.

14. An issue of public use or on sale activity has been raised in this application. In order for the examiner to properly consider patentability of the claimed invention under 35 U.S.C. 102(b),

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additional information regarding this issue is required as follows: the earliest release date and availability of the above mentioned trademark by the assignee of the claimed invention.

Applicant is reminded that failure to fully reply to this requirement for information will result in a holding of abandonment.

15. Claims 1-28 are rejected under 35 U.S.C. 102(c) because the invention has been abandoned. The claimed invention was presented in any one of copending applications 08/882,140, 09/083,345 and 09/157,150 assigned to the same inventive entity. Both of those applications have been expressly abandoned such that the present claimed invention is also considered abandoned.

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

18. Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over an obvious variation of examiner's personal experience of a method and system of vending machine operation as part of the examiner's routine purchase or refilling of a drink at a Cocoa-Cola labeled soft drink dispensing machine outside a retail establishment with electrical power to mechanically operate the soft drink dispensing machine. The claimed selection signal, automatic transmission, and data communication controller are considered automation of a old and well known practice which will be discussed infra. The claimed vending machine, customer, and retail establishment are considered non-functional descriptive material which will also be discussed infra. Since at least 1990, examiner has performed the claimed invention as a soft drink dispensing machine purchaser which encompasses the claimed method and system of vending machine operation comprising:

receiving a request for a transaction from a customer at the vending machine optionally including customer proximity;

identifying or determining a condition at a retail establishment or determining whether a requested transaction can be performed by the vending machine optionally including a trigger signal; and

based on the identified condition or trigger signal if the transaction can be performed, outputting to the customer in response or offer to the received request; or

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a vending machine including offer means for selectively outputting an offer;

detection means or trigger generating signal means located at a retail establishment for detecting a condition at the retail establishment optionally including retail establishment trigger signal transmission means; and

communication means for allowing data communication between said detection means and said offer means optionally including offer means outputting an offer in response to the trigger signal are part of examiner's experience. Examiner also has personal experience with the claimed steps of coupon redemption including code, sales frequency, service queue, inventory and stock, identified condition, human or automatic signal transmission, and remote controller or vending machine location. As a soft drink purchaser, examiner has frequently observed the claimed method and system for promoting sales. The claimed receiving a request for a transaction from a customer at the vending machine optionally including customer proximity and based on the identified condition or trigger signal if the transaction can be performed, outputting to the customer in response or offer to the received request are considered equivalent to coinage insertion into a soft drink dispensing machine associated with a promoter of Cocoa-Cola. The claimed vending machine including offer means for selectively outputting an offer is considered again equivalent to the soft drink dispenser responding to the examiner proper insertion of coinage in the proximity of the machine by displaying a signal or dispensing a soft drink. The claimed detection means or trigger generating signal means located at a retail establishment for detecting a condition at the retail establishment optionally including retail establishment trigger

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signal transmission means is considered equivalent to the soft drink dispensing machine operating as intended if a retail establishment has electrical power supplied to the machine for cooling and coinage-soft drink transactional exchange. The claimed communication means for allowing data communication between said detection means and said offer means optionally including offer means outputting an offer in response to the trigger signal is considered equivalent to either the soft drink purchaser or an examiner machine refiller communicating transactionally with the soft drink machine. The claimed steps of coupon redemption including code, sales frequency, service queue, inventory and stock, identified condition, human or automatic signal transmission, and remote controller or vending machine location are considered equivalent to old and well known steps use by the examiner in dealing with soft drink machine purchases and machine refilling. The claimed invention, recited by the applicant, has been provided examiner personal experience long before the filing of applicant's invention. Examiner notes that it is old and well known to those skilled in the art of promoting sales, that it would have been obvious to claim the invention as recited by the applicant, in order to overcome the explicit teachings of examiner's personal experience discussed supra. The claimed invention contains automated features, such as selection signal, automatic transmission, and data communication controller, which are obvious variations to the examiner's experience that is so old and well known that the examiner will use Official notice to obviate that claimed subject matter. It would have been obvious to one skilled in the art to provide the automated claimed steps since those features are merely automated features of a concept that is old and well known.

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Please see *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) in which the court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art. Furthermore the claimed invention has been part of examiner's experience except for the claimed vending machine, customer, and retail establishment. The claimed vending machine, customer, and retail establishment are merely representative information that is considered non-functional descriptive language. It would have been obvious to those skilled in the art of promoting sales to use those terms to seek patent protection. The non-functional descriptive language including the terms vending machine, customer, and retail establishment are considered merely a position for offering an item, product, or service. These non-functional descriptive language differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The claimed reward and condition steps would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 32 F. 3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to claim vending machine, customer, and retail establishment having any type of content, because such data does not functionally relate to the steps in the method and system claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention. Additionally the claimed invention has been part of examiner's experience except for the claimed selection signal, automatic transmission, and data

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communication controller. Selection signal, automatic transmission, and data communication controller are an obvious automated variation to the traditional rewards experienced by most soft drink purchasers or refillers skilled in the art. Automation does not impart patentability as discussed in applying *Venner* to the examination of the present application. The motivation to combine applicants claimed invention with the examiner's personal experience is to allow merchants greater consumer targeting capabilities, which clearly shows the obviousness of the claimed invention.

Double Patenting

19. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

20. Claims 1-28 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of any of the copending Application No. 09/218085, 09/540709, 09/994810, 09/688372, or 09/713001. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present application contains the an obvious variation recitation in claim language as applied to the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

21. Claims 1-28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-36 of U.S. Patent No. 5,988,346 because the patented redemption request and inventory retrieval are obvious variations to the present application claims including selectively outputting an offer including triggers with response, are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-37 of U.S. Patent No. 6,317,649 because the patented receiving a purchase request and customer question or promotion presentation steps are obvious variations to


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the present application claims including customer transaction request and performance determination steps, or are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-48 of U.S. Patent No. 6,324,520 because the patented purchaser selection receiving and product offering are an obvious variation to the present application claims including customer transaction request and customer offer outputting. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present application contains obvious variant recitations which are obvious variations of the patented invention features since both comparisons perform the same function, in the same way with the same result.

Conclusion

22. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Steve Gravini whose telephone number is (703) 308-7570 and electronic transmission / e-mail address is "steve.gravini@uspto.gov". Examiner can normally be contacted Monday through Friday from 6:00 a.m. to 3:30 p.m. **If applicant chooses to send information by e-mail, please be aware that confidentiality of the electronically transmitted message cannot be assured.** Please see MPEP 502.02. Information may be sent to the Office by facsimile transmission. The Official Fax Numbers for TC-3600 are:

After-final	(703) 872-9327
Official	(703) 872-9326
Non-Official/Draft	(703) 872-9325


STEPHEN GRAVINI
PRIMARY EXAMINER

smg
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